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Applicant : Stiles, Sharidan Lorraine
App. No : 10/648,686
Filed : August 25, 2003
For : PERSONAL SHAVING RAZOR
Examiner : Jason D. Prone
Art Unit : 3724

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January 20, 2006

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Ned A. Israelsen, Reg. No. 29,655

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Commissioner for Patents

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Alexandria, VA 22313-1450

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Transmitted herewith for filing in the above-identified application are the following enclosures:

(X) Appeal Brief in 36 pages.

FILING FEES:

The present application qualifies for Small Entity Status under 37 CFR 1.27.

FEE CALCULATION				
FEE TYPE		FEE CODE	CALCULATION	TOTAL
Appeal Brief	41.20(b)(2)	2402 (\$250)		\$250
1 Month Extension	1.17(a)(1)	2251 (\$60)		\$
2 Month Extension	1.17(a)(2)	2252 (\$225)		\$
3 Month Extension	1.17(a)(3)	2253 (\$510)		\$
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(X) An Amendment Filed With Appeal Brief Pursuant to 37 C.F.R. § 41.33(b) in 5 pages is enclosed.

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Docket No. : STILES.1C1CP1

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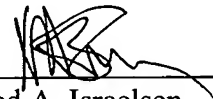
Application No. : 10/648,686

Filing Date : August 25, 2003

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Stiles, Sharidan Lorraine
Appl. No. : 10/648,686
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January 20, 2006

(Date)

Ned A. Israelsen, Reg. No. 29,655

AMENDMENT FILED WITH APPEAL BRIEF PURSUANT TO 37 C.F.R. § 41.33(b)

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Please amend the application as follows.

Amendments to the Claims are reflected in the listing of claims which begins on page 2 of this paper.

Remarks/Arguments begin on page 5 of this paper.

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Appl. No. : **10/648,686**
Filed : **August 25, 2003**

AMENDMENTS TO THE CLAIMS

1. (Previously Presented) A personal styling razor, comprising:
a handle portion having lower, middle and upper longitudinal portions; and
a head portion, having a razor blade with a straight cutting edge, attached to said upper longitudinal portion;
wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;
wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle that is less than or equal to ninety degrees; and
wherein said head portion has a width of less than or equal to one inch.
2. (Original) The personal styling razor of Claim 1, wherein said head portion is replaceable.
3. (Original) The personal styling razor of Claim 1, wherein said head portion is pivotally mounted on said handle portion.
4. (Previously Presented) A personal styling razor, comprising:
a handle portion having lower, middle and upper longitudinal portions; and
a head portion, having a razor blade with a straight cutting edge, attached to said upper longitudinal portion;
wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;
wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle wherein said control angle is greater than ninety degrees; and
wherein said head portion has a width of less than or equal to one inch.
5. (Previously Presented) The personal styling razor of Claim 1, wherein a length of said upper longitudinal portion is greater than said width of said head portion.

Appl. No. : 10/648,686
Filed : August 25, 2003

6. (Original) The personal styling razor of Claim 1, further comprising a second razor blade mounted substantially parallel to said razor blade.

7. (Original) The personal styling razor of Claim 1, wherein said lower longitudinal portion comprises a first curved shape and said middle longitudinal portion comprises a second curved shape and wherein said first and second curved shapes form an ergonomically advantageous grip for said personal styling razor.

8. (Original) The personal styling razor of Claim 1, further comprising a glide surface area and a blade area, wherein said glide surface area is larger than said blade area.

9. (Canceled).

10. (Currently Amended) ~~The detail shaving razor of Claim 9,~~ A detail shaving razor, comprising:

an ergonomically shaped handle portion; and

a head portion attached to said handle portion and formed with at least one razor blade having a straight cutting edge;

wherein said head portion is less than or equal to 1/2 inch wide;

wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;

wherein said handle portion is adapted to provide increased control over the head portion during shaving;

wherein said handle portion further comprises:

a lower longitudinal portion of a first curved shape; and

a middle longitudinal portion of a second curved shape attached lengthwise to said first longitudinal portion;

wherein a waist portion is formed between said first curved shape and said second curved shape.

11. (Original) The detail shaving razor of Claim 10, wherein said head portion is replaceable.

12. (Original) The detail shaving razor of Claim 10, wherein said head portion is pivotally mounted on said handle portion.

13. (Canceled).

Appl. No. : **10/648,686**
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14. (Canceled).
15. (Previously Presented) The detail shaving razor of Claim 10, further comprising a second razor blade mounted substantially parallel to said razor blade.
16. (Canceled).
17. (Canceled).
18. (Canceled).
19. (Canceled).
20. (Previously Presented) A personal styling razor, comprising:
a shaving head having at least one razor blade, wherein said shaving head is less than or equal to three-eighths of an inch wide, wherein said razor blade has a straight cutting edge which is substantially perpendicular to a longitudinal axis of the handle;
a generally arcuate handle having means for improving manipulation of said shaving head, wherein the width of at least a portion of said handle is substantially larger than the width of said shaving head.
21. (Previously Presented) The personal styling razor of Claim 1, wherein said head portion is equal to or less than 1/4 inch wide.
22. (Previously Presented) The personal styling razor of Claim 1, wherein said head portion is equal to or less than 1/8 inch wide.
23. (Previously Presented) The detail shaving razor of Claim 10, wherein said head portion is equal to or less than 1/4 inch wide.
24. (Previously Presented) The detail shaving razor of Claim 10, wherein said head portion is equal to or less than 1/8 inch wide.
25. (Previously Presented) The personal styling razor of Claim 20, wherein said shaving head is less than or equal to 1/4 of an inch wide.
26. (Previously Presented) The personal styling razor of Claim 20, wherein said shaving head is less than or equal to 1/8 of an inch wide.
27. (Previously Presented) The personal styling razor of Claim 4, wherein said head portion is equal to or less than 1/4 inch wide.
28. (Previously Presented) The personal styling razor of Claim 4, wherein said head portion is equal to or less than 1/8 inch wide.

Appl. No. : 10/648,686
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REMARKS

Claims 9 and 13-14 have been canceled. Applicants maintain that the cancellation of a claim makes no admission as to its patentability and reserve the right to pursue the subject matter of the cancelled claim in this or any other patent application. Claim 10 which previously depended from Claim 9 has been rewritten in independent form to include all of the claim limitations of canceled Claim 9.

Applicant respectfully submits that the amendment conforms to 37 C.F.R. § 41.33(b) which states that amendments to the claims may be filed with the appeal brief to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form. Therefore Applicant respectfully requests that the amendment be entered for purposes of appeal.

CONCLUSION

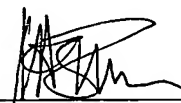
Applicant invites the Examiner to call the undersigned if any issues might be resolved by telephone.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1-20-06

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

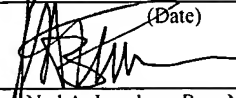
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Ned A. Israelsen, Reg. No. 29,655

APPELLANT'S BRIEF

Mail Stop Appeal Brief - Patents
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Alexandria, VA 22313-1450

Appellant in the above-captioned patent application is appealing the final rejection of claims 1-8, 10-12, 15 and 20-28, all pending claims in this case, in a final Office Action dated August 25, 2005. Pursuant to 37 C.F.R. § 1.191, the examiner's decision in the patent application is therefore in condition for appeal to the Board of Patent Appeals and Interferences.

If for some reason Appellant has not paid sufficient fee for filing this appeal brief, please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

TABLE OF CONTENTS

TABLE OF CONTENTS	2
RELATED APPEALS & INTERFERENCES.....	3
STATUS OF CLAIMS	3
STATUS OF AMENDMENTS.....	3
SUMMARY OF INVENTION.....	4
ISSUE(S) ON APPEAL	5
GROUPING OF CLAIMS.....	5
ARGUMENT.....	6
<u>Summary of the Law for a rejection under 35 U.S.C. § 103(a)</u>	<u>6</u>
<u>Claims 1-8, 21-22 and 27-28 – The modified Hollinger reference does not meet all the</u> <u>limitations of Independent Claims 1 and 4</u>	<u>6</u>
<i>Claim 5 and 7 – The modified Hollinger reference does not meet all the</i> <i>limitations of Dependent Claims 5 and 7.....</i>	<i>10</i>
<i>Claim 4, 27-28 – The modified Hollinger reference does not meet all the</i> <i>limitations of Independent Claim 4.....</i>	<i>12</i>
<u>Claims 1-8, 21-22 and 27-28 – The Examiner has not established a suggestion or</u> <u>motivation to modify the device of Hollinger in view of Carreker, Heller, Crawford or</u> <u>Smith.....</u>	<u>13</u>
<i>Claims 21-22 and 27-28 – The Examiner has not established a suggestion or</i> <i>motivation to further modify the device of Hollinger as combined with</i> <i>Carreker, Heller, Crawford or Smith</i>	<i>18</i>
<u>Claims 10-15 and 23-24 – The Examiner has not established a suggestion or motivation</u> <u>to modify the device of Hollinger in view of Carreker, Heller, Smith or Heinrich</u>	<u>21</u>
<i>Claims 23-24 – The Examiner has not established a suggestion or motivation to</i> <i>further modify the device of Hollinger as combined with Carreker, Heller,</i> <i>Smith or Heinrich in view of Crawford</i>	<i>24</i>
<u>Claims 10-12, 15 and 23-24 – The modified Hollinger reference does not meet all the</u> <u>limitations of Independent Claim 10.....</u>	<u>27</u>
<u>Claims 20 and 25-26 – The Examiner has not established a suggestion or motivation to</u> <u>modify the device of Hollinger in view of Carreker, Heller, Smith or Heinrich, or</u> <u>further in view of Crawford</u>	<u>29</u>
<u>Conclusion</u>	<u>31</u>
APPENDIX A – CLAIMS ON APPEAL	32
APPENDIX B – Evidence.....	35
APPENDIX C – Related Proceedings	36

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

REAL PARTY IN INTEREST

The real party in interest is the inventor, Sharidan L. Stiles, of Redding, CA.

RELATED APPEALS & INTERFERENCES

A Notice of Appeal and Appeal Brief have been filed in the related application, U.S. Application Serial No. 10/219,095, from which the present application claims priority as a continuation-in-part. Appellant is unaware of any other related appeals or interferences.

STATUS OF CLAIMS

The instant application was filed on August 25, 2003 with twenty claims. Claims 16-19 were canceled, and new claims 21-28 were added in an Amendment and Response to Office Action dated May 31, 2005. Appellant files herewith an Amendment canceling claims 9 and 13-14, and rewriting claim 10 in independent form. Claims 1-8, 10-12, 15 and 20-28 stand rejected, and are the subject of this appeal. The claims as listed in Appendix A reflect the Amendment filed herewith.

STATUS OF AMENDMENTS

Appellant filed an Amendment and Response to Office Action dated May 31, 2005, which the Examiner indicated was entered in a Final Office Action mailed August 25, 2005. In the Final Office Action, the Examiner objected to the Drawings as not showing every feature of the claimed invention. Therefore, Appellant filed an Amendment and Response to Final Office Action on October 25, 2005, amending the specification and substituting a Replacement Sheet illustrating FIG. 6A and FIG. 6B for sheet three of four which illustrated FIG. 6. The Examiner mailed an Advisory Action on November 8, 2005, maintaining the rejection of the pending claims. However, the Advisory Action does not indicate whether Appellant's amendment to the specification and replacement sheet were entered by the Examiner.

Appellant respectfully submits that the Amendment and Response to Final Office Action conforms to 37 C.F.R. § 1.116 as it places the application in better form for appeal. The amendment does not necessitate a new search, does not raise an issue of new matter, does not present additional claims without canceling a corresponding number of rejected claims, and does not otherwise introduce new issues. Therefore Appellant respectfully requests that the

Appl. No. : 10/648,686
Filed : August 25, 2003

Amendment and Response to Final Office Action be entered for purposes of appeal if it has not already been entered.

Appellant also submits herewith an Amendment filed with Appeal Brief Pursuant to 37 C.F.R. § 41.33(b), canceling claims 9 and 13-14 and rewriting claim 10 in independent form. Appellant respectfully submits that the amendment conforms to 37 C.F.R. § 41.33(b) which states that amendments to the claims may be filed with the appeal brief to cancel claims, where such cancellation does not affect the scope of any other pending claim in the proceeding, or to rewrite dependent claims into independent form. Therefore Appellant respectfully requests that the amendment to the claims be entered for purposes of appeal.

SUMMARY OF INVENTION

Generally, Appellant's invention is directed to a styling and grooming razor used for shaving body hair in hard-to-reach or awkward places. For example, the razor could be used to groom the eyebrows, moustache, nose, sideburns, scalp, abdomen, bikini area, toes, etc.¹ The Appellant has discovered that in creating a very small razor that can be used to precisely shave carefully delineated areas of the body, the relationships between the handle and the head of the razor and/or the blade are advantageously different from the corresponding relationships between larger, more conventional razors.

Thus, in one embodiment the present application claims razors comprising a handle portion having lower, middle and upper longitudinal portions and a head portion having a razor blade integrally attached to the head portion and the razor blade has a width of less than or equal to one inch. In one embodiment, the lower longitudinal portion extends along a first axis and the upper longitudinal portion extends along a second axis and the first and second axes form a control angle that is less than or equal to ninety degrees, while in another embodiment the control angle is greater than ninety degrees.² In another embodiment the razor comprises an ergonomically shaped handle portion, a head portion that is less than or equal to 1/2 inch wide with at least one razor blade, where the handle portion is adapted to provide increased control

¹ See *Specification* at ¶ [0019].

² *Id.* at [0005], [0029].

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

over the head portion during shaving.³ In another embodiment, the claimed razor comprises a shaving head that is less than or equal to three-eighths of an inch wide and has at least one razor blade and a generally arcuate handle having means for improving manipulation of said shaving head, where the width of at least a portion of the handle is substantially larger than the width of the shaving head.⁴

Such razors are defined herein as “styling razors” or “detail shaving razors” and the handles and heads cooperate to allow precise control, e.g., for shaving patterns or precise lines.

ISSUE(S) ON APPEAL

The issue on appeal is whether claims 1-8, 10-15 and 20-28 are improperly rejected under 35 U.S.C. § 103(a) as being unpatentable over Design Patent 259, 743 to Hollinger in view of Carreker, U.S. Patent 4,461,078, Heller, U.S. Patent 4,700,477, Crawford, U.S. Patent 2,547,376, Smith U.S. Patent 4,335,509, Branchinelli *et al.* U.S. Patent 6,052,905, Heinrich, U.S. Patent 2,139,680, White, U.S. Patent 4,719,063, Holley, U.S. Patent 6,049,936, Brody, U.S. Patent 4,523,781, Beebe, U.S. Patent 4,283,808, Gaide, U.S. Patent 2,367,571, Lovasz, U.S. Patent 2,743,732, and/or Bosy *et al.*, U.S. Patent 6,598,303.

GROUPING OF CLAIMS

In arguing patentability of the claims, where a number of claims contain features which are believed to be common to these claims and patentable over the art, the claims will be discussed in groups. It is believed that the following claim groups stand or fall together:

Group 1: claims 1-3, 6 and 8.

Group 2: claims 10-12 and 15.

For the reasons discussed below, Appellant believes that each of the remaining claims being appealed is separately patentable. It is to be understood that the above claim groups only stands or falls together insofar as the particular rejections before the Board apply. It is believed that there are patentable distinctions among all claims.

³ See, e.g., claim 10.

⁴ See, e.g., claim 20.

Appl. No. : 10/648,686
Filed : August 25, 2003

ARGUMENT

Summary of the Law for a rejection under 35 U.S.C. § 103(a)

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.⁵ The teaching or suggestion to make the claimed combination and the reasonable expectation of success must be found in the prior art and not based on Applicants' disclosure.⁶ One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.⁷ Additionally, the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of operation of a reference.⁸ Second, there must be a reasonable expectation of success.⁹ Finally, the prior art reference (or references when combined) must teach or suggest all of the claim limitations.¹⁰ "All words in a claim must be considered in judging the patentability of that claim against the prior art."¹¹ Applicant respectfully submits that the Examiner failed to establish a *prima facie* case of obviousness as required by 35 U.S.C. § 103(a).

Claims 1-8, 21-22 and 27-28 – The modified Hollinger reference does not meet all the limitations of Independent Claims 1 and 4

Pending claims 1 and 4, and therefore dependent claim 2-3, 5-8, 21-22, and 27-28 require that the claimed razor have "a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle" which is "less than or equal to ninety degrees" in claim 1, and "greater than ninety degrees" in claim 4. The

⁵ *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

⁶ *Id.*

⁷ *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

⁸ *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810 (CCPA 1959).

⁹ *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991).

¹⁰ *Id.*

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

Examiner relies on the handle disclosed in Hollinger, U.S. Design Patent 259,743, as applied to claims 1 and 4 to reject claims 1-8, 21-22 and 27-28. *See Final Office Action* at 3,4, 5-6, 7, 8, 12, 14, 20 and 21.

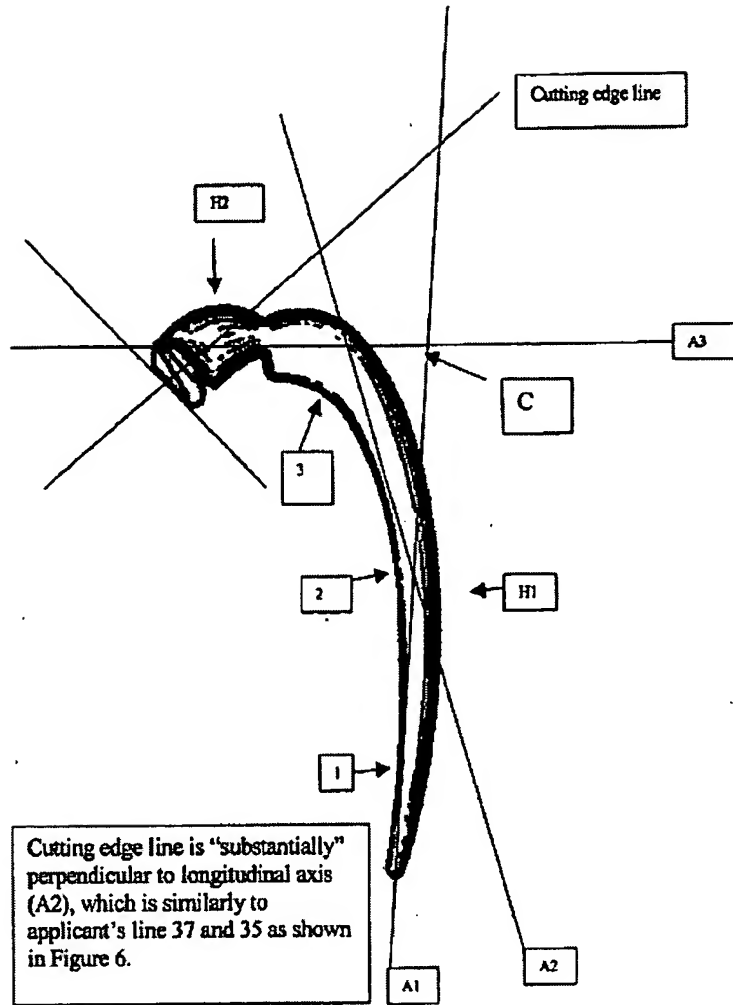
In rejecting claim 1, the Examiner argues that:

Hollinger discloses the same invention as claimed including, e.g., a handle portion (H1) having a lower (1), middle (2), upper (3) longitudinal portions; and a head portion (H2) having a razor blade (see claim) attached to said upper longitudinal portion (see Figure 1); wherein the lower longitudinal portion extends along a first axis (A1), the middle longitudinal portion extends along a second axis (A2); and the upper longitudinal portion extends along a third axis (A3). The first and third axes form a control angle (C) that is less than ninety degrees (see the Figure below). *Final Office Action* at 3.

The Examiner makes the same arguments in rejecting claims 4-8 under 35 U.S.C. § 103(a) as unpatentable over Hollinger. *See id.* at 5-6. Appellant respectfully disagrees.

The “Figure below” from the Final Office Action referred to in the above paragraph rejecting claim 1 and claim 4, and relied on for the rejection of dependent claims 2-3, 5-8, 21-22 and 27-28 is reproduced below.

¹¹ *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (CCPA 1970); *see also* M.P.E.P. § 2143.03.



Final Office Action at 24.

Applicant turns first to the third element of a prima facie case of obviousness – that the prior art reference(s) must teach or suggest all the claim limitations. As mentioned above, pending claims 1 and 4, and therefore dependent claim 2-3, 5-8, 21-22, and 27-28 require that the claimed razor have “a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle.”

As can be seen in the figure above, the handle disclosed by Hollinger is a continuous curve. As a result, contrary to the Examiner's assertion, Hollinger does not disclose a handle having lower, middle and upper longitudinal portions that extend along a first, second, and third axis. The continuous nature of the curve means that any arbitrary designation of a particular

Appl. No. : 10/648,686
Filed : August 25, 2003

point on the curve as the lower, middle, or upper portions of the curve does not result in that portion of the curve extending along an identifiable first, second, or third axis as required by claims 1-8, 21-22 and 27-28. This is made apparent by the fact that the placement of the lines A1, A2, and A3 in the above figure is completely arbitrary and does not reflect actual features of the handle.

For example, because any part of the curved handle could be designated the “lower portion,” the line A1 could arbitrarily be placed anywhere along the continuous curve of the handle. As a result, the “control angle (C)” identified by the Examiner could have a value of less than 90 degrees, equal to 90 degrees, or greater than 90 degrees, depending on where line A1 and/or A3 is placed. As the Examiner must acknowledge, claim 1 and claim 4 differ in their scope due to the recited value for the control angle – less than or equal to ninety degrees for claim 1, and greater than ninety degrees for claim 4. The fact that the Hollinger reference does not disclose the recited handle elements discussed above is made obvious by the fact that based on the Examiner’s reasoning, a single handle disclosed in Hollinger anticipates both claim 1 and claim 4 – claims which are mutually exclusive in scope. Simply put, a continuous curve has no first, second, or third axis and thus cannot satisfy the claim. Further, there are no separately identifiable “longitudinal portions.”

The distinction between Hollinger and the claimed invention of claims 1-8, 21-22 and 27-28 is clearly shown in the embodiment of handle illustrated in Figure 6A of the instant application (reproduced below), which has identifiable lower, middle and upper longitudinal portions that extend along a first, second, and third axis, and thus has a defined control angle – the placement of lines 33, 35 and 37 in Figure 6A are not arbitrary.

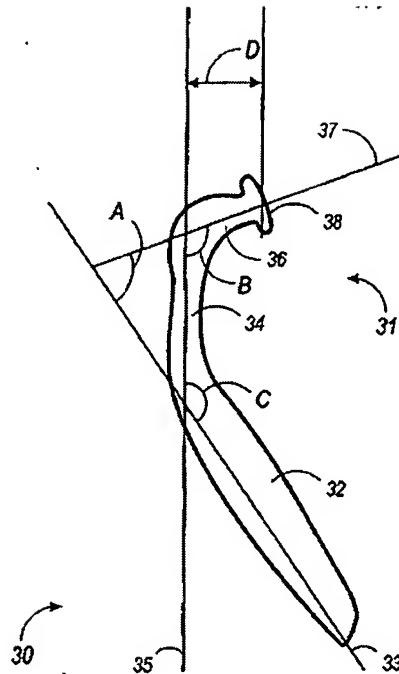


FIG. 6A

Thus, Applicants submit that Hollinger, even when combined with Carreker, Heller, Crawford, or Smith, lacks the limitation “a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle..” For at least this reason, Appellant respectfully submits that claims 1-8, 21-22 and 27-28 are not obvious in light of the cited art, and requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claim 5 and 7 – The modified Hollinger reference does not meet all the limitations of Dependent Claims 5 and 7

In addition to not satisfying all of the limitation of independent claims 1 and 4 as discussed above, the Hollinger reference also does not disclose all of the limitations of dependent claims 5 and 7.

Claim 5

Appellant turns first to claim 5, which requires that “a length of said upper longitudinal portion is greater than said width of said head portion.” The Examiner argues that “[a]s to claim

Appl. No. : 10/648,686
Filed : August 25, 2003

5, Figure 1 of Hollinger clearly shows the upper longitudinal portion being greater than the width of the blade.”¹² *Final Office Action* at 7.

The Examiner’s argument rests on the assertion that Hollinger discloses a lower, middle and upper longitudinal portion of the handle as recited in claim 1. As discussed above, Appellant submits that Hollinger does not disclose a lower, middle and upper longitudinal portion of the handle as recited in claim 1. Therefore, there is no “upper longitudinal portion,” the length of which is greater than said width of said head portion, and the cited references do not teach or suggest all of the claim limitations. For this additional reason, the Examiner has failed to establish a prima facie case of obviousness. Appellant therefore respectfully submits that claim 5 is not obvious in light of the cited art, and requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claim 7

Claim 7 recites the limitation “wherein said lower longitudinal portion comprises a first curved shape and said middle longitudinal portion comprises a second curved shape and wherein said first and second curved shapes form an ergonomically advantageous grip for said personal styling razor.”

The Examiner argues that:

As to claim 7, the modified device of Hollinger discloses the use of the lower portion having a first curved shape and the middle portion having a second curved shape as shown in Figure 1 of Hollinger. It should be noted that the phrase “wherein said first... razor” does not serve to distinguish the claimed invention from the prior art because it is a recitation of intended use not defining any specific structure. *Final Office Action* at 7.

Appellant submits that portions (1) and (2) of Hollinger as identified by the Examiner as the lower and middle longitudinal portions are not a **first curved shape** and a **second curved shape**, but rather are a single curved shape. As explained in detail above, there is no support in Hollinger for the Examiner’s division of this single curve into two or more portions, and doing so does not create a first and second curved shape. This is in contrast to the distinct first and second curved portions of the handle shown in the embodiment illustrated in Figure 1 of the instant application.

¹² Appellant notes for the record that the claim recites the upper longitudinal portion is greater

Appl. No. : 10/648,686
Filed : August 25, 2003

Because the cited references do not teach or suggest all of the claim limitations, the Examiner has failed to establish a prima facie case of obviousness. Appellant therefore respectfully submits that for this additional reason, claim 7 is not obvious in light of the cited art, and requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claim 4, 27-28 – The modified Hollinger reference does not meet all the limitations of Independent Claim 4

Claim 4, and therefore dependent claims 27-28, require that “said first and third axes form a control angle wherein said control angle is greater than ninety degrees.”

As discussed above, the Examiner rejects claim 4 as unpatentable under 35 U.S.C. § 103(a) over Hollinger in view of additional references, relying on the same arguments made in rejecting claim 1. *See Final Office Action* at 5-6. The Examiner acknowledges that claim 4 differs from claim 1 in that the recited control angle is greater than ninety degrees in claim 4, however the Examiner states, that “it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a control angle of greater than ninety degrees ” *Id.* at 6. The Examiner argues that “it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art.” *Final Office Action* at 6-7 (emphasis added).

As discussed above, contrary to the Examiner’s assertion, Hollinger does not disclose “a handle portion having lower, middle and upper longitudinal portions; ...wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle.” In the absence of any of these claimed features of the invention, the cited art does not disclose “the general conditions of a claim,” and therefore “discovering the optimum or workable ranges” does not involve only routine skill in the art. Instead, to discover a control angle greater than ninety degrees as recited in claim 4, one of skill in the art would first have to invent the claimed handle having lower, middle and upper axes where the first and third axes form a control angle. As these elements are not disclosed in the

than said width of said head portion, not the blade.

Appl. No. : 10/648,686
Filed : August 25, 2003

prior art, the element of a control angle greater than ninety degrees recited in claim 4 and dependent claims 27-28 is also not disclosed or obvious.

Because the cited references do not teach or suggest all of the claim limitations, the Examiner has failed to establish a prima facie case of obviousness. Appellant therefore respectfully submits that for this additional reason, claim 4 and dependent claims 27-28 are not obvious in light of the cited art, and requests that the rejections under 35 U.S.C. §103(a) be withdrawn.

Claims 1-8, 21-22 and 27-28 – The Examiner has not established a suggestion or motivation to modify the device of Hollinger in view of Carreker, Heller, Crawford or Smith

Claims 1 and 4, and therefore dependent claims 2-3 and 5-8 require that the head portion of the claimed invention have “a width of less than or equal to one inch.”

The Examiner has rejected claims 1-8 under 35 U.S.C. § 103(a) as unpatentable over Hollinger in view of Carreker, U.S. Patent 4,461,078, Heller, U.S. Patent 4,700,477, Crawford, U.S. Patent 2,547,376, or Smith U.S. Patent 4,335,509. *Final Office Action* at 3, 4 and 5.

The Examiner acknowledges that Hollinger “lacks the razor blade having a width of less than or equal to one inch.” *Final Office Action* at 4. However, the Examiner argues that “Carreker discloses that is it old and well known in the art to use razor blades of reduced size such less than one inch for the purpose of provided [sic] an improved razor with an enhanced cutting ability of specific small areas of the body. Moreover, Heller, Crawford and Smith all disclose reduced razor head widths with non-straight handles for increased handling of the razor.” *Id.* The Examiner concludes that therefore, “it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced razor blade size of less than one inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming.” *Id.* The Examiner makes the same arguments rejecting claim 4. *Id.* at 6.

In addition to not satisfying the third element of a prima facie case of obviousness – that the prior art reference(s) must teach or suggest all the claim limitations – as discussed above, Appellant submits that the Examiner has also failed to satisfy the first element of a prima facie case of obviousness – that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify

Appl. No. : 10/648,686
Filed : August 25, 2003

the reference or combine reference teachings. “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’” *M.P.E.P.* §2142, *quoting Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (BPAI 1985).

Appellant submits that the Examiner has not established any motivation to combine the decorative handle of Hollinger with the small blade head disclosed by Carreker, Heller, Crawford, or Smith. The M.P.E.P. states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *M.P.E.P.* §2143.01 (emphasis added). In addition, the M.P.E.P. requires that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P.* §2141.02 (emphasis in original).

The Carreker reference discloses a handle with two straight portions, and a razor head mounted at the ends of the handle portions. *Carreker* at FIGs. 1-3. The handle portions are “pivotally mounted together so that the heads may be moved from a position wherein the handle portions are substantially in a straight line” to a closed position where the heads are close to each other. *Carreker* at Abstract. In the Detailed Description of the Drawings, Carreker teaches that that when the handles are in straight line position shown in FIG. 1, “the razors ... are disposed for use in shaving.” *Carreker* at col. 2, lines 59-68 (emphasis added). The fact that the assembly is used for shaving with the handles in the straight line position shown in FIGS. 1 and 5 is repeated elsewhere as well. *Carreker* at col. 3, lines 58-59. In addition, Carreker teaches that the two handle portions are provided with “stops ... formed integrally therewith for defining the first [straight line] position (FIG. 1) of the handle portions.” *Carreker* col. 3, lines 22-27.

When the two-piece handle of Carreker is in a straight line, it is essentially a single, long straight handle. Carreker could have placed the stops such that the two handles formed any angle around the pivot point. In doing so, Carreker could have created a handle that more closely resembled the one disclosed in Hollinger, or the instant application. However, rather than

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

choosing some angle less than or greater than 180 degrees, Carreker chose to create essentially a straight handle for shaving. Thus, when the whole of the Carreker reference is considered, it clearly teaches away from combining the disclosed smaller razor head with anything other than a straight handle. Hollinger, as a design patent, teaches absolutely nothing with regard to reasons to combine it with the Carreker reference.

Similarly, the Heller reference discloses an “eyebrow trimmer” that “consists of three basic elements, (1) the razor blade, (2) the front safety head guard for the razor, and (3) the rear safety head guard.” *Heller* at Abstract. Heller teaches that “[t]he eyebrow trimmer is mounted at a comfortable operating angle on a handle having a textured grip for easy holding and manipulating of the eyebrow trimmer.” *Id.* at Abstract and col. 2, lines 16-19 (emphasis added). The handle of the Heller device is illustrated in FIGs. 1 and 2. The handle illustrated is essentially straight, with the textured portion described in the abstract. *Id.* at FIGs 1 and 2, and col. 2, lines 16-19.

Given this teaching in Heller, the reference actually teaches away from combining the razor head of Heller with the handle of Hollinger. First, Hollinger does not disclose a handle with at “textured grip for easy holding” as described in Heller. Second, Heller describes a “comfortable operating angle” between the head of the device and the handle. Figures 1 and 2 of Heller illustrate the angle at which the head is attached to the handle.

Referring to the figure from Hollinger as labeled by the Examiner, it can be seen that the angle at which the razor head of Hollinger is attached to the handle is less than ninety degrees (approximately 55 degrees) when measured as the angle between the “cutting edge line” and either A1 or A2. If FIG. 2 of Heller is similarly labeled (see figure below), with a line along the major longitudinal axis of the handle (“A1 or A2”) and a line perpendicular to the face of the razor head (“cutting edge line”), the resulting angle between the two (“Angle A”) is much greater than ninety degrees (approximately 135 degrees). Hence, using the same measure of the “operating angle,” Heller teaches an angle of 135 degrees, while combining the head portion of Heller with the handle of Hollinger results in an “operating angle” of approximately 55 degrees. For this reason additional reason, Heller teaches away from combining the small razor head of Heller with the handle of Hollinger.

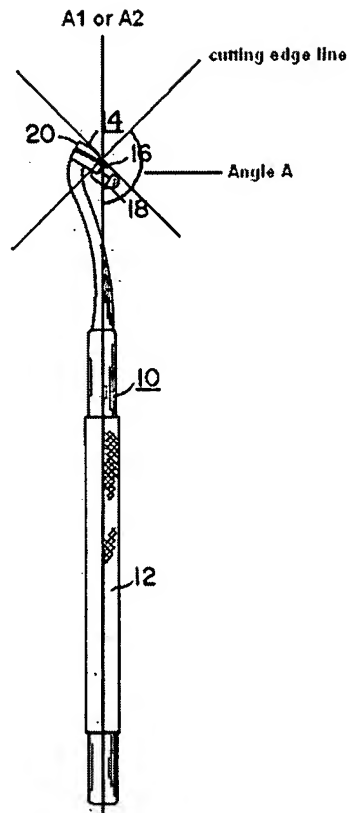


FIG. 2

Heller at FIG. 2.

Appellant turns next to the Crawford reference which discloses an eyebrow shaver. The Crawford reference discloses a eyebrow razor having a “suitable supporting frame or structure,” including a handle:

The upper end of the frame or structure 1 terminates in a blade securing portion 3 comprising integral spaced elements or finger members 4 and 5, each of which is provided with a vertical slot 6 to receive and support a blade 7. ... The blade 7 is thin and flat and is adapted to be inserted in position by passing it through a narrow slot 9 formed in the part 8 of the structure. The blade is inserted by slipping the same into the slot 9, and it is guided by the grooves 6, 6 in the members or projections 4 and 5. ... The upper end of the blade may be provided with an outwardly extending elongation 11 which projects a predetermined distance beyond the edge of the structure 1 at the part 3 so as to permit easy and instant removal and application of the blade in position. *Crawford* at col. 2, lines 13-42 (emphasis added).

Appl. No. : 10/648,686
Filed : August 25, 2003

Thus, Crawford teaches a blade which is slidably and removably mounted in the handle through a slot built into the head of the razor. The removability of the blade is illustrated in the figures, which show a blade secured by a set screw or a spring pressed ball. *See Crawford* at FIGs. 1-15; col. 2, lines 45-52; and col. 3, lines 37-40.

One of the main objects of the Crawford invention is the slot structure of the handle for receiving the removable blade, as is evident by its inclusion in every embodiment. Therefore, there is no motivation to combine the removable slot blade disclosed by Crawford, and the standard razor head and handle disclosed in Hollinger. The resulting modified device would not only be inoperable since there is no structure in the Hollinger handle to receive the removable blade of Crawford, but any combination of the two references would change the principle of operation of a reference, a result which prohibits a conclusion of obviousness.¹³ Therefore, the Examiner has failed to establish a motivation to combine the Hollinger and Crawford references.

Finally, Appellant turns to the last reference relied on by the Examiner. Smith discloses a beard and moustache trimmer which the Summary of the Invention describes:

The hair trimming implement includes an elongated handle with an attached unitary blade and shank. One end of the shank is aligned with the axis of the handle to which it is attached. The other portion of the shank extends angularly away from the axis of the handle to a union with the blade wherefrom the blade appends angularly towards the handle and terminates at an oblique cutting edge which extends across the width of the blade. The end portions of the cutting edge extend beyond the sides of the shank thereby exposing the ends to the view of the user. *Smith* at col. 1, line 60, through col. 2, line 3 (emphasis added).

The Examiner does not specify how one would combine the “unitary blade and shank” of Smith with the decorative handle of Hollinger, and nothing in either reference teaches or suggests combining the references. It is clear from the illustrations and teachings of Smith that the handle portion of the Smith device is straight, and adapted to accept the non-blade end of the shank, such that the shank “is aligned with the axis of the handle to which it is attached.” There is no way the unitary shank and blade of Smith can be combined with the handle of Hollinger such that the modified device is operable. Appellant reminds the PTO that the proposed modification cannot render the prior art unsatisfactory for its intended purpose or change the principle of

¹³ *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Appl. No. : 10/648,686
Filed : August 25, 2003

operation of a reference.¹⁴ Clearly, the combination of Smith and Hollinger would be unsatisfactory for its intended purpose.

In addition, Smith teaches that a benefit to the user of the Smith device is “the exposure to view of the ends 9 of the cutting edge, which project beyond the sides of the shank 4.” *Smith* at col. 3, lines 16-18. Therefore, even if one were to integrate the blade portion of the unitary blade and shank of Smith into the head portion of the Hollinger handle, the beneficial feature of exposing the ends of the cutting edge to the user would be lost, since the head portion of Hollinger surrounds the blade. *See Hollinger* at FIG. 2. Therefore, for this additional reason, rather than suggesting a motivation to combine the references, Smith actually teaches away from the combination of Smith and Hollinger.

In conclusion, the Examiner has not offered any satisfactory reason or motivation to combine the Hollinger and Carreker, Heller, Crawford, or Smith references, and references themselves teach away from the combination. Therefore, Appellant submits that the Examiner has failed to establish the first element of a prima facie case of obviousness. For this additional reason, Appellant respectfully submits that claims 1-8 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 21-22 and 27-28 – The Examiner has not established a suggestion or motivation to further modify the device of Hollinger as combined with Carreker, Heller, Crawford or Smith

Claims 21 and 22 depend from claim 1, with claim 21 reciting the additional limitation “wherein said head portion is equal to or less than 1/4 inch wide,” and claim 22 reciting the limitation “wherein said head portion is equal to or less than 1/8 inch wide.” Similarly, claims 27 and 28 depend from claim 4, with claim 27 reciting the additional limitation “wherein said head portion is equal to or less than 1/4 inch wide,” and claim 28 reciting the limitation “wherein said head portion is equal to or less than 1/8 inch wide.” The Examiner has rejected claims 21-22 and 27-28 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Crawford, or Smith as applied to claim 1, and in view of additional arguments. *Final Office Action* at 12, 14, 20 and 21. Appellant submits that for the reasons discussed above, the

¹⁴ *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re Ratti*, 270 F.2d 810 (CCPA 1959).

Appl. No. : 10/648,686
Filed : August 25, 2003

Examiner has not provided sufficient arguments that the cited references suggest or disclose a motivation to combine the Hollinger references with Carreker, Heller, Crawford or Smith. In addition, Appellant submits that the Examiner's further arguments fail to provide a motivation to further modify the Hollinger device such that the devices of claims 21-22 and 27-28 are obvious.

Claims 21 and 27

The Examiner has rejected claim 21 and 27 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Crawford, or Smith as applied to claim 1, in view of additional arguments. *Final Office Action* at 12 and 20. The Examiner acknowledges that cited references do not disclose every element of claims 21 and 27, making the identical statement with respect to both claims: "The modified device of Hollinger discloses the invention substantially as claimed except for the specific head portion width being equal to or less than ¼ inch." *Id.* at 12 and 20. Therefore, to overcome this shortcoming in the cited references, the Examiner argues that it would have been obvious to make the head portion of the claimed razor equal to or less than 1/4 inch wide.

The Examiner offers three arguments to support this assertion, making identical arguments with respect to both claims 21 and 27. First, the Examiner argues that "Heller and Crawford both disclose that it is old and well known in the art to use blades of ¼ of inch for the purpose of providing reduced sized shaving like implements for improved cutting ability of specific small areas of the body," and therefore the claimed invention is obvious. *Id.* at 12-13 and 20-21. Alternatively, The Examiner argues that "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art," and therefore the claimed invention is obvious. *Id.* at 13 and 21. Finally, the Examiner asserts that making the head portion 1/4 inch wide was "an obvious matter of design choice." *Id.* at 13 and 21.

Appellant respectfully submits that these arguments fail because they rest on the assumption that there is a motivation to combine the cited references in the first place. Appellant respectfully submits that for the reasons articulated above, no such motivation exists. In the absence of a motivation to combine the Hollinger reference with any of the other references relied on by the Examiner, the "design choice" to modify the head portion of the Hollinger razor

Appl. No. : 10/648,686
Filed : August 25, 2003

to be equal to or less than 1/4 inch is not an obvious one since Hollinger provides not motivation or guidance for making such a modification.

Claims 22 and 28

Like claims 21 and 27, the Examiner has rejected claims 22 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Crawford, or Smith as applied to claim 1, in view of additional arguments. *Final Office Action* at 14 and 21. As with claims 21 and 27, the Examiner acknowledges that cited references do not disclose every element of claims 22 and 28, making the identical statement with respect to both claims: “The modified device of Hollinger discloses the invention substantially as claimed except for the specific head portion width being equal to or less than 1/8 inch.” *Id.* at 14 and 22. Therefore, to overcome this shortcoming in the cited references, the Examiner argues that it would have been obvious to make the head portion of the claimed razor equal to or less than 1/8 inch wide, offering the same three arguments made regarding claims 21 and 27. *Id.* at 14 and 22.

Appellant respectfully submits that these arguments fail for the same reason articulated above – they rest on the assumption that there is a motivation to combine the cited references in the first place. As discussed above, no such motivation exists. In the absence of a motivation to combine the Hollinger reference with any of the other references relied on by the Examiner, the “design choice” to modify the head portion of the Hollinger razor to be equal to or less than 1/8 inch is not an obvious one since Hollinger provides not motivation or guidance for making such a modification. In addition, Appellant submits that a 1/8 inch wide head is not taught by any of the cited prior art, and the motivation for reducing the size of the head to such a small size is not found in the prior art.

In conclusion, the Examiner has not offered any satisfactory reason or motivation to combine the Hollinger and Carreker, Heller, Crawford, or Smith references, and references themselves teach away from the combination. In the absence of any motivation to combine these references, the Examiner’s arguments regarding the obviousness of further modifying the references to reduce the head portion to 1/4 or 1/8 inch must fail. Therefore, Appellant submits that the Examiner has failed to establish the first element of a *prima facie* case of obviousness with respect to claims 21-22 and 27-28. For this additional reason, Appellant respectfully

Appl. No. : 10/648,686
Filed : August 25, 2003

submits that claims 21-22 and 27-28 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 10-15 and 23-24 – The Examiner has not established a suggestion or motivation to modify the device of Hollinger in view of Carreker, Heller, Smith or Heinrich

As amended in the Amendment filed herewith, claim 10, and therefore dependent claims 11-15 and 23-24, recites a detail shaving razor comprising an ergonomically shaped handle portion wherein the handle portion comprises “a lower longitudinal portion of a first curved shape; and a middle longitudinal portion of a second curved shape attached lengthwise to said first longitudinal portion; wherein a waist portion is formed between said first curved shape and said second curved shape.”

The Examiner has rejected pending claims 10-11 and 13-15 under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Carreker, and Heller, Smith or Heinrich, U.S. Patent 2,139,680. *Final Office Action* at 8 and 9. Claim 12 is rejected under 35 U.S.C. 103(a) over the same art as applied to claims 10-11 and 13-15, and further in view of Branchinelli et al., U.S. patent 6,052,905. *Id.* at 10. Claims 23-24 are rejected over Hollinger in view of Carreker, and Heller, Smith or Heinrich as applied to claim 10 and further in view of Crawford. *Id.* at 15 and 16.

In rejecting claims 10-15 and 23-24, the Examiner states that “Hollinger discloses the invention substantially as claimed as set forth in the previous office action but lacks the razor head having a width of less than or equal to 1/2 inch.” *Id.* at 8. In the previous Office Action, the Examiner argued that Hollinger discloses the same invention as claimed including, e.g., “an ergonomically shaped handle portion (H1) having a lower (1), middle (2), upper (3) longitudinal portions; and a head portion (H2) having a having a razor blade (see claim) attached to said upper longitudinal portion (see Figure 1).” *First Office Action* at 8.

The Examiner goes on to argue that:

However, Carreker discloses that it is old and well known in the art to use reduced size head portions of about ½ inch for the purpose of providing an improved razor with an enhanced cutting ability of specific small areas of the body. Furthermore, Heller, Smith and Heinrich all disclose that it is old and well known in the art to use razor blades of reduced size such less than or equal to 1/2 inch with non-straight handles for the purpose of provided an improved razor with an enhanced

Appl. No. : 10/648,686
Filed : August 25, 2003

cutting ability of specific small areas of the body. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced head portion with razor blades with sizes of less than or equal to ½ an inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming, as taught by Carreker, Heller, Smith, and Heinrich. *Final Office Action* at 8.

As stated above, the first element of a prima facie case of obviousness is a that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. “The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. ‘To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.’” *M.P.E.P.* §2142, *quoting Ex parte Clapp*, 227 U.S.P.Q. 972, 973 (BPAI 1985).

Appellant submits that the Examiner has not established any motivation to combine or the decorative handle of Hollinger and with the small blade disclosed by Carreker, Heller, Smith and Heinrich. The *M.P.E.P.* states that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” *M.P.E.P.* §2143.01 (emphasis added). In addition, the *M.P.E.P.* requires that “[a] prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” *M.P.E.P.* §2141.02 (emphasis in original). Similarly, “[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *M.P.E.P.* §2143.01. Finally, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious.” *Id.*

Appellant has addressed the Examiner’s combination of Hollinger and Carreker, Heller, Smith, or Crawford above. As discussed at length above with respect to claims 1-8, 21-22 and 27-28, Appellant submits that the Examiner has failed to establish a motivation to combine these

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

references. This same reasoning applies to claims 10-12, 15 and 23-24, and Appellant will not repeat these arguments here. *See Discussion Supra*.

Appellant therefore turns to the Examiner's suggested combination of the Hollinger and Heinrich references. First, Appellant submits that the Examiner has not provided any motivation to combine the razor disclosed in Heinrich with the handle disclosed in Hollinger. As mentioned above, the M.P.E.P. states that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." M.P.E.P. §2143.01 (emphasis added). Similarly, "[i]f [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *M.P.E.P.* §2143.01.

The device of claims 10-15 is a "detail shaving razor." The dictionary definition of "shave" is "to sever the hair (from the head or another part of the body) close to the roots." Webster's Ninth New Collegiate Dictionary, 1983. Appellant has expressly adopted this definition of shaving. The razor disclosed by Heinrich is designed for the purpose of cutting hair in the nostrils and ears (col. 1, lines 5-23), but does not shave a body part. Referring to Figures 1-3 of Heinrich, the blade 17 overlays a plate 10 with teeth 11 that extend well beyond the blade. This prevents cuts when poking the cutting head into the nose or the ears, but it also prevents the blade from severing the hair "close to the roots" as is required when shaving. This reference is outside of the family of razors that shave a body surface. For example, if one were to use the razor described by Heinrich in the bikini area, the stubble created by such an incomplete hair removal would lead to intense irritation.

In addition, the blade disclosed in Heinrich is curved, further diminishing its usefulness as a "detail shaving" razor. The present invention is directed to precise shaving to shape body hair such as the eyebrows or a mustache, often involving cutting single hairs. The curved blade of Heinrich makes cutting fine details difficult compared to blades which are straight. These difference exclude Heinrich from the devices to which one trying to shave a difficult area, (e.g., the eyebrows, scalp, sideburns and bikini area) would look for guidance. Heinrich does not teach a razor capable of achieving such a goal. Therefore, there is no motivation to combine the Heinrich and Hollinger references to create a "detail shaving" razor.

Appl. No. : 10/648,686
Filed : August 25, 2003

Also contrary to any motivation to combine the Hollinger and Heinrich references is the fact that the resulting device would not be operable for the purpose of either of the cited references. If the standard blade of Hollinger were replaced with the smaller curved blade of Heinrich, the resulting device would be inoperable for the purpose of trimming the hair inside the nose and ears as taught in the Heinrich reference. The standard size razor head of Hollinger, even with a small razor blade, would not fit into the nostril of the ear. Similarly, shaving large areas of the body such as the face or legs would be impractical with the standard razor of Hollinger combined with the small blade of Heinrich. Thus, the combined device would be inoperable for the purposes disclosed in either Hollinger or Heinrich. "If [the] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *M.P.E.P.* §2143.01.

In conclusion, the Examiner has not offered any satisfactory reason or motivation to combine the Hollinger and Carreker, Heller, Smith or Heinrich references, and references themselves teach away from the combination. Therefore, Appellant submits that the Examiner has failed to establish the first element of a prima facie case of obviousness. For this reason, Appellant respectfully submits that claims 10-15 and 23-24 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

Claims 23-24 – The Examiner has not established a suggestion or motivation to further modify the device of Hollinger as combined with Carreker, Heller, Smith or Heinrich in view of Crawford

Claims 23-24 depend from claim 10, with claim 23 reciting the additional limitation "wherein said head portion is equal to or less than 1/4 inch wide," and claim 24 reciting the limitation "wherein said head portion is equal to or less than 1/8 inch wide." The Examiner has rejected claims 23-24 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Smith, or Heinrich as applied to claim 10, and further in view of Crawford. *Final Office Action* at 15 and 16. Appellant submits that for the reasons discussed above, the Examiner has not provided sufficient arguments that the cited references suggest or disclose a motivation to combine the Hollinger references with Carreker, Heller, Smith or Heinrich. In

Appl. No. : 10/648,686
Filed : August 25, 2003

addition, Appellant submits that the Examiner's further arguments regarding the combination of Hollinger and Crawford also fail to provide a motivation to further modify the Hollinger device such that the devices of claims 23-24 are obvious.

Claim 23

The Examiner has rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Smith or Heinrich as applied to claim 10, in further view of Crawford. *Final Office Action* at 15. The Examiner acknowledges that cited references do not disclose every element of claim 23, stating: "[t]he modified device of Hollinger discloses the invention substantially as claimed except for the specific head portion width being equal to or less than 1/4 inch." *Id.* Therefore, to overcome this shortcoming in the cited references, the Examiner argues that it would have been obvious to make the head portion of the claimed razor equal to or less than 1/4 inch wide.

The Examiner offers three arguments to support this assertion. First, the Examiner argues that "Heller and Crawford both disclose that it is old and well known in the art to use blades of 1/4 of inch for the purpose of providing reduced sized shaving like implements for improved cutting ability of specific small areas of the body," and therefore the claimed invention is obvious. *Id.* Alternatively, the Examiner argues that "it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art," and therefore the claimed invention is obvious. *Id.* Finally, the Examiner asserts that making the head portion 1/4 inch wide was "an obvious matter of design choice." *Id.* at 16.

Appellant respectfully submits that these arguments fail because they rest on the assumption that there is a motivation to combine the cited references in the first place. Appellant respectfully submits that for the reasons articulated above, no such motivation exists for the hindsight combination of Hollinger with Carreker, Heller, Smith or Heinrich. As for the Crawford reference, Appellant has already addressed the lack of a motivation to combine this reference with Hollinger. *See Discussion Supra.*

In the absence of a motivation to combine the Hollinger reference with any of the references relied on by the Examiner, the "design choice" to modify the head portion of the

Appl. No. : 10/648,686
Filed : August 25, 2003

Hollinger razor to be equal to or less than 1/4 inch is not an obvious one since Hollinger provides not motivation or guidance for making such a modification.

Claim 24

Like claim 23, the Examiner has rejected claim 24 under 35 U.S.C. § 103(a) as being unpatentable over Hollinger in view of Carreker, Heller, Smith or Heinrich as applied to claim 10, in further view of Crawford. *Final Office Action* at 16. As with claim 23, the Examiner acknowledges that cited references do not disclose every element of claim 24, stating that “[t]he modified device of Hollinger discloses the invention substantially as claimed except for the specific head portion width being equal to or less than 1/8 inch.” *Id.* at 16. Therefore, to overcome this shortcoming in the cited references, the Examiner argues that it would have been obvious to make the head portion of the claimed razor equal to or less than 1/8 inch wide, offering the same three arguments made regarding claim 23. *Id.* at 16-17.

Appellant respectfully submits that these arguments fail for the same reason articulated above – they rest on the assumption that there is a motivation to combine the cited references in the first place. As discussed above, no such motivation exists. In the absence of a motivation to combine the Hollinger reference with any of the other references relied on by the Examiner, the “design choice” to modify the head portion of the Hollinger razor to be equal to or less than 1/8 inch is not an obvious one since Hollinger provides not motivation or guidance for making such a modification. In addition, Appellant submits that a 1/8 inch wide head is not taught by any of the cited prior art, and the motivation for reducing the size of the head to such a small size is not found in the prior art.

In conclusion, the Examiner has not offered any satisfactory reason or motivation to combine the Hollinger and Carreker, Heller, Smith, Heinrich or Crawford references, and the references teach away from the combination. In the absence of any motivation to combine these references, the Examiner’s arguments regarding the obviousness of further modifying the references to reduce the head portion to 1/4 or 1/8 inch must fail. Therefore, Appellant submits that the Examiner has failed to establish the first element of a *prima facie* case of obviousness with respect to claims 23-24. For this additional reason, Appellant respectfully submits that claims 23-24 are not obvious in light of the cited art, and request that the rejection under 35 U.S.C. §103(a) be withdrawn.

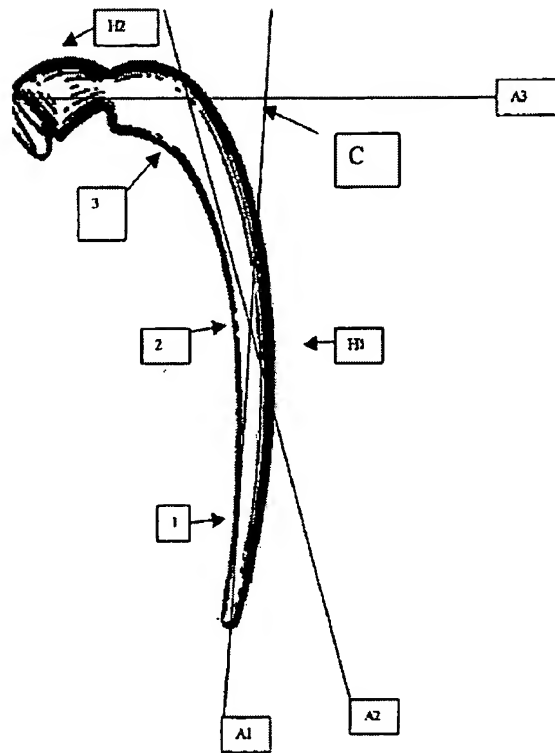
Appl. No. : 10/648,686
Filed : August 25, 2003

Claims 10-12, 15 and 23-24 – The modified Hollinger reference does not meet all the limitations of Independent Claim 10

In addition to failing to establish a motivation to combine the cited references as discussed above, the Examiner has also failed to establish the third element of a prima facie case of obviousness – that the prior art reference(s) must teach or suggest all the claim limitations. As amended, the detail shaving razor of independent claim 10 and therefore dependent claims 11-12, 15 and 23-24 recite a detail shaving razor comprising an ergonomically shaped handle portion wherein the handle portion comprises “a lower longitudinal portion of a first curved shape; and a middle longitudinal portion of a second curved shape attached lengthwise to said first longitudinal portion; wherein a waist portion is formed between said first curved shape and said second curved shape.”

In rejecting pending claims 10-12, 15 and 23-24, as mentioned above, the Examiner states that “Hollinger discloses the invention substantially as claimed as set forth in the previous office action but lacks the razor head having a width of less than or equal to 1/2 inch.” *Id.* at 8. In the previous Office Action, the Examiner argued that Hollinger discloses the same invention as claimed including, e.g., “an ergonomically shaped handle portion (H1) having a lower (1), middle (2), upper (3) longitudinal portions; and a head portion (H2) having a having a razor blade (see claim) attached to said upper longitudinal portion (see Figure 1).” *First Office Action* at 8.

The “Figure 1” referred to in the First Office Action is a modified FIG. 1 taken from Hollinger, which is reproduced from the First Office Action below.



First Office Action at 14.

Appellant submits that portions (1) and (2) of Hollinger as labeled by the Examiner and shown above are not a **first curved shape** and a **second curved shape**, but rather are a single curved shape. As discussed previously, there is no support in Hollinger for the Examiner's division of this single curve into two portions, and doing so does not create a first and second curved shape. This is in contrast to the distinct first and second curved portions of the handle shown in embodiment illustrated in Figure 1 of the instant application.

It is patently inconsistent for the examiner to argue that the continuously curving Hollinger handle has three separate axes (*i.e.*, three straight portions) in connection with one set of rejections, and two separate curves in connection with a second set of rejections, and is generally arcuate in yet another set of rejections (see discussion of claim 20 below).

For at least these reasons, Appellant submits that the Examiner has failed to establish that the cited references teach or suggest all the claim limitations of claims 10-15 and 23-24. Appellant therefore submits that for this additional reason, the Examiner has failed to establish a prima facie case of obviousness in light of the cited art for claims 10-12, 15 and 23-24, and requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Appl. No. : 10/648,686
Filed : August 25, 2003

Claims 20 and 25-26 – The Examiner has not established a suggestion or motivation to modify the device of Hollinger in view of Carreker, Heller, Smith or Heinrich, or further in view of Crawford

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hollinger in view of Carreker, or Heller or Smith or Heinrich and White, U.S. Patent 4,719,063, or Holley, U.S. Patent 6,049,936, or Brody, U.S. Patent 4,523,781, or Beebe, U.S. Patent 4,283,808, and/or Gaide, U.S. Patent 2,367,571, or Lovasz, U.S. Patent 2,743,732, or Bosy et al., U.S. patent 6,598,303. *Final Office Action* at 10.

The Examiner argues that “Hollinger discloses the invention substantially as claimed including a generally arcuate handle with means (the curved upper end) for improved manipulation. Hollinger discloses the use of a razor blade with a straight cutting edge, which is substantially perpendicular to a longitudinal axis of the handle.” *Id.* at 10. The Examiner acknowledges that Hollinger lacks the shaving head being less than or equal to three-eighths of an inch wide. *Id.* at 11. However, the Examiner argues that:

Carreker et al. discloses that it is old and well known in the art to use reduced size head portions of about ½ inch for the purpose of providing an improved razor with an enhanced cutting ability of specific small areas of the body. Furthermore, Heller, Smith and Heinrich all disclose that it is old and well known in the art to use razor blades of reduced size such less than or equal to 1/2 inch and some with non-straight handles for the purpose of provided an improved razor with an enhanced cutting ability of specific small areas of the body. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to use a reduced head portion with razor blades with sizes of less than or equal to ½ an inch with the safety razor of Hollinger in order to provide an enhanced cutting razor for specific grooming, as taught by Carreker, Heller, Smith, and Heinrich. *Final Office Action* at 11.

Claims 25 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over the same art as applied to claim 20 and further in view of Crawford. *Id.* at 18 and 19. The Examiner acknowledges that the modified device of Hollinger does not disclose “the specific head portion width being equal to or less than ¼ inch,” with respect to claim 25, or “equal to or less than 1/8 inch” with respect to claim 26. *Final Office Action* at 18 and 19. Therefore, to overcome this shortcoming in the cited references, the Examiner argues that it would have been obvious to make the head portion of the claimed razor equal to or less than 1/4 or 1/8 inch wide.

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

The Examiner offers three arguments to support this assertion, making the same arguments with respect to both claims. First, the Examiner argues that “Heller and Crawford both disclose that it is old and well known in the art to use blades of ¼ of inch for the purpose of providing reduced sized shaving like implements for improved cutting ability of specific small areas of the body,” and therefore the claimed invention is obvious. *Id.* at 18 and 19. Alternatively, the Examiner argues that “it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art and it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art,” and therefore the claimed invention is obvious. *Id.* at 18 and 19-20. Finally, the Examiner asserts that making the head portion 1/4 or 1/8 inch wide was “an obvious matter of design choice.” *Id.* at 18-19 and 20.

Appellant has addressed the Examiner’s combination of Hollinger and Carreker, Heller, Smith, or Heinrich, and further in view of Crawford above. As discussed at length above with respect to claims 1-8, 10-12, 15, 21-24 and 27-28, Appellant submits that the Examiner has failed to establish a motivation to combine these references. This same reasoning applies to claims 20 and 25-26, and Appellant will not repeat these arguments here. *See Discussion Supra.* Therefore, because the Examiner has failed to establish at least this element of a prima facie case of obviousness for claims 20 and 25-26, Appellant requests that the rejection under 35 U.S.C. §103(a) be withdrawn.

Appl. No. : 10/648,686
Filed : August 25, 2003


Conclusion

For the reasons discussed above, Appellant submits that the Examiner has failed to establish a prima facie case of obviousness with respect to pending claims 1-8, 10-12, 15 and 20-28. In particular, the Examiner has failed to establish any suggestion or motivation to combine the cited references, and even when combined, the cited references do not teach or suggest all of the claimed limitations. Appellant submits that the claim limitations discussed above represent only illustrative distinctions from the prior art. There may be other patentable features that distinguish the claimed invention from the prior art. In view of the foregoing, Appellant respectfully submits that the rejection of claims 1-8, 10-12, 15 and 20-28 under 35 U.S.C. § 103(a) be withdrawn, and that those claims be allowed.

Respectfully submitted,

KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated: 1-20-06

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APPENDIX A – CLAIMS ON APPEAL

1. A personal styling razor, comprising:
a handle portion having lower, middle and upper longitudinal portions; and
a head portion, having a razor blade with a straight cutting edge, attached to said upper longitudinal portion;
wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;
wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle that is less than or equal to ninety degrees; and
wherein said head portion has a width of less than or equal to one inch.
2. The personal styling razor of Claim 1, wherein said head portion is replaceable.
3. The personal styling razor of Claim 1, wherein said head portion is pivotally mounted on said handle portion.
4. A personal styling razor, comprising:
a handle portion having lower, middle and upper longitudinal portions; and
a head portion, having a razor blade with a straight cutting edge, attached to said upper longitudinal portion;
wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;
wherein said lower longitudinal portion extends along a first axis, said middle longitudinal portion extends along a second axis and said upper longitudinal portion extends along a third axis and wherein said first and third axes form a control angle wherein said control angle is greater than ninety degrees; and
wherein said head portion has a width of less than or equal to one inch.
5. The personal styling razor of Claim 1, wherein a length of said upper longitudinal portion is greater than said width of said head portion.
6. The personal styling razor of Claim 1, further comprising a second razor blade mounted substantially parallel to said razor blade.

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

7. The personal styling razor of Claim 1, wherein said lower longitudinal portion comprises a first curved shape and said middle longitudinal portion comprises a second curved shape and wherein said first and second curved shapes form an ergonomically advantageous grip for said personal styling razor.

8. The personal styling razor of Claim 1, further comprising a glide surface area and a blade area, wherein said glide surface area is larger than said blade area.

9. (Canceled.)

10. A detail shaving razor, comprising:

an ergonomically shaped handle portion; and

a head portion attached to said handle portion and formed with at least one razor blade having a straight cutting edge;

wherein said head portion is less than or equal to 1/2 inch wide;

wherein said cutting edge of said razor blade is substantially perpendicular to a longitudinal axis of the handle;

wherein said handle portion is adapted to provide increased control over the head portion during shaving;

wherein said handle portion further comprises:

a lower longitudinal portion of a first curved shape; and

a middle longitudinal portion of a second curved shape attached lengthwise to said first longitudinal portion;

wherein a waist portion is formed between said first curved shape and said second curved shape.

11. The detail shaving razor of Claim 10, wherein said head portion is replaceable.

12. The detail shaving razor of Claim 10, wherein said head portion is pivotally mounted on said handle portion.

13. (Canceled).

14. (Canceled).

15. The detail shaving razor of Claim 10, further comprising a second razor blade mounted substantially parallel to said razor blade.

16. (Canceled).

Appl. No. : **10/648,686**
Filed : **August 25, 2003**

17. (Canceled).
18. (Canceled).
19. (Canceled).
20. A personal styling razor, comprising:
 - a shaving head having at least one razor blade, wherein said shaving head is less than or equal to three-eighths of an inch wide, wherein said razor blade has a straight cutting edge which is substantially perpendicular to a longitudinal axis of the handle;
 - a generally arcuate handle having means for improving manipulation of said shaving head, wherein the width of at least a portion of said handle is substantially larger than the width of said shaving head.
21. The personal styling razor of Claim 1, wherein said head portion is equal to or less than 1/4 inch wide.
22. The personal styling razor of Claim 1, wherein said head portion is equal to or less than 1/8 inch wide.
23. The detail shaving razor of Claim 10, wherein said head portion is equal to or less than 1/4 inch wide.
24. The detail shaving razor of Claim 10, wherein said head portion is equal to or less than 1/8 inch wide.
25. The personal styling razor of Claim 20, wherein said shaving head is less than or equal to 1/4 of an inch wide.
26. The personal styling razor of Claim 20, wherein said shaving head is less than or equal to 1/8 of an inch wide.
27. The personal styling razor of Claim 4, wherein said head portion is equal to or less than 1/4 inch wide.
28. The personal styling razor of Claim 4, wherein said head portion is equal to or less than 1/8 inch wide.

Appl. No. : 10/648,686
Filed : August 25, 2003

APPENDIX B – EVIDENCE

Appellant has not cited any evidence other than the references cited by Examiner.

Appl. No. : 10/648,686
Filed : August 25, 2003

APPENDIX C – RELATED PROCEEDINGS

None – There are no decisions rendered by a court or the Board in any related proceedings identified above.

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